

REMARKS-General

1. Upon review of the original specification and in light of the observation of the Examiner noted in the above Office Action, the applicant has amended the specification which is deemed to more clearly and distinctly describe the subject matter of the instant invention, and which provides full antecedent basis to the newly drafted claims. No new matter has been included in the amended specification.

2. The newly drafted independent claim 21 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 21-33 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Response to Rejection of Claims 1-20 under 35USC103

3. The Examiner rejected claims 1-20 over Murray (US 6,324,769) in view of no other cited art. Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

4. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

5. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Murray which is qualified as prior art of the

instant invention under 35USC102(b) are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

6. It is worth to mention that the tape measure is such a simple article of manufacture that merely includes a tape casing and a ruler blade retractably received in the tape casing between a storage position and a measuring position. At the storage position, the ruler blade is retracted to receive in the receiving cavity in a coil flattened configuration manner via a retraction unit, and at the measuring position, the outer end of the ruler blade is slidably pulled to extend the ruler blade in a concave-convex configuration out of the receiving cavity of the tape casing.

Prima Facia Case of Obviousness

7. The applicant respectfully submits that to reject claims in a patent application under 35 U.S.C. 103, the Examiner must show an un rebutted prima facie case of obviousness. See *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995).

8. A prima facie case of obviousness requires setting forth:

- (a) the differences in the claim over the applied references,
- (b) the proposed modification of the applied references necessary to arrive at the claimed subject matter, and
- (c) an explanation why such proposed modification would be obvious. MPEP §706.02.

9. In establishing a prima facie case of obviousness, the Examiner must make the four factual inquiries sent forth by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Specifically, the four factual inquiries required by Graham are as follows:

- (a) Determining of the scope and contents of the prior art;
- (b) Ascertaining the differences between the prior art and the claims in issue;
- (c) Resolving the level of ordinary skill in the pertinent art; and

(d) Evaluating evidence of secondary consideration.

10. These factors have not been appropriately applied in this case. In addition, when applying 35 USC 103, the following tenets of patent law must be adhered to:

(a) The claimed invention must be considered as a whole;

(b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(c) The references must be viewed without the benefit of hindsight vision afforded by the claimed invention; and

(d) Reasonable expectation of success is the standard with which obviousness is determined.

11. Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

12. As established below, these factors and criteria clearly point to the nonobviousness of the claimed invention.

13. Claim 21 of the instant invention is directed to a strengthened blade tape measure comprising a tape casing having a receiving cavity and a guider opening communicating with the receiving cavity, a retraction unit supported in the receiving cavity, and a ruler blade, having an inner end attached to the retraction unit and an outer end stopped at the guider opening, adapted to slidably fold between a storage position and a measuring position. In which, at the storage position, the ruler blade is retracted to receive in the receiving cavity in a coil flattened configuration manner via the retraction unit, and at the measuring position, the outer end of the ruler blade is slidably pulled to extend the ruler blade in a concave-convex configuration out of the receiving cavity through the guider opening. The ruler blade has a width in the flattened configuration thereof having a dimension within a range of 41-42mm, a height in the concave-convex configuration thereof having a dimension within a range of 9-12mm, and a thickness thereof having a dimension at least 0.2mm, such that the ruler blade is capable of standing out from the tape casing with a measuring length at least 10 feet in a self-sustaining manner so as to prevent the ruler blade from buckling by its own

weight. The ruler blade has a longitudinal central portion and two longitudinal side portions integrally extended from two sides of the central portion of the ruler blade respectively, wherein each of the side portions of the ruler blade has a curvature smaller than a curvature of the central portion of the ruler blade, wherein the central portion of the ruler blade has a width in the concave-convex configuration thereof having a dimension within a range of 20-22mm, a height in the concave-convex configuration thereof having a dimension within a range of 3-4mm. Murray describes a tape measure having a blade of a thickness of 0.114-0.16mm, the blade having a width in a flattened configuration within a range of 23-28mm, a height in a concave-convex configuration within a range of 6.35-10.16mm, side portions having the central portion having a radius of 15mm and a projecting angle of 84 degrees. Therefore, the blade is enabled to stand out accurately a length measured along the blade of at least 10.5 feet with a horizontal linear length of standout thereof being greater than 97% of the arcuate length of standout. The Examiner, indeed, recognizes these dimensional limitations are different from the dimensional limitations in the claim 21 of the instant invention.

14. The Examiner states Murray discloses the dimensional limitations for the ruler blade can be chosen by one of average skill in the art. The Examiner also indicated the dimensions of the ruler blade are considered to be optimum values that would be determined using routine experimentation for increasing standout. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the ruler blade with the specific values to increase the stability of the ruler when extended.

15. Applicant respectfully submits that the ruler blade of the instant invention has its unique dimensions to be retracted to receive in the tape casing in a coil flattened configuration manner and to stand out from the tape casing with a measuring length at least 10 feet in a self-sustaining manner so as to prevent the ruler blade from buckling by its own weight. In addition, if the dimension of the ruler blade can be simply modified with Murray, as proposed by the Examiner, the dimensions of the ruler blade of the instant invention should totally fall into the dimensional range of the ruler blade claimed by Murray.

16. Regarding to Claims 21-33, Murray does not teach any range of ruler blade width in flattened configuration, the thickness of the ruler blade in the concave-convex

configuration, the range of the central portion width, the range of the central portion height, the side projecting angle of the side portion, the radius of the central portion and the central projecting angle of the central portion. In other words, claims 21-33 of the instant invention provide a very specific combination of the dimensions for a concavo-convex type ruler blade, which combination of dimensions is nowhere suggested in the prior art of record including Murray.

17. It is submitted that the dimensional limitations set forth in claims 21-33 are not all mere optimization of values, and that any indication by Examiner that these limitations are obvious requires impermissible hindsight speculation.

18. Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

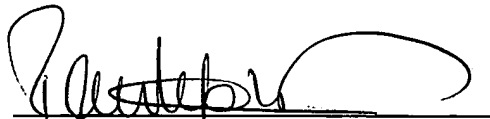
The Cited but Non-Applied References

19. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

20. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 21-33 at an early date is solicited.

21. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

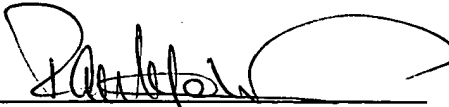


Raymond Y. Chan
Reg. Nr.: 37,484
108 N. Ynez Ave.
Suite 128
Monterey Park, CA 91754
Tel.: 1-626-571-9812
Fax.: 1-626-571-9813

CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 01/24/2005

Signature: 
Person Signing: Raymond Y. Chan

